



**\*\*Please place on Upper Right Corner\*\***  
**\*\*of Response to Office Action ONLY.\*\***

Examining Attorney: JACKSON, STEVEN

Serial Number: 76/659543

Attorney Docket No.: 290883US56

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**  
**TRADEMARK EXAMINING OPERATION**

In re the Application of:

CHICAGO PNEUMATIC TOOL  
COMPANY

Application Serial No.: 76/659,543

Filed: May 3, 2006

Mark: SPRINGHAMMER & DEVICE

Class: 7

Honorable Commissioner for Trademarks  
P.O. Box 1451  
Alexandria, VA 22313-1451

Examining Attorney

Steven Jackson

Law Office 107

**BOX RESPONSES**  
**NO FEE**

Dear Commissioner:



10-23-2007

U.S. Patent & TMO/TM Mail Rpt. Dt.

**RESPONSE FOR RECONSIDERATION**

This is a Response to the Office Action mailed April 25, 2007. The period for Response is set to expire on October 25, 2007.

**AMENDMENT**

Please delete the identification of goods in International Class 7 in its entirety and substitute therefor the following:

--Power tools, namely, wrenches, torque controlled wrenches, electric brushless plugging and tightening wrenches, blow guns, sanders and polishers, grinders, planing machines, shears, saws, reciprocating saws, nibblers, high speed cutters, drills, in-line drills, angle drills, multi-drills, rack feed drills, constant feed drills, peck feed drills, portable feed drill concentric colleting system, industrial rivet hammers, vibration reduced hammers, rivet shavers/millers, screwdrivers, rotary screw compressors, battery-powered screwdrivers, high power and standard electric screwdrivers, low voltage screwdrivers and mains voltage screwdrivers, tappers, pistol grip nut runners, in-line nut runners, angle head nut runners, fixture spindles, frangible collar fastener, vacuum cleaners, engraving pen,

needle scaler, machine tools and tools for use with machine tools, namely, pneumatic compression tools; namely, c yoke, alligator jaws, sheet metal punch, edge former, and stand alone power units for compression riveters; pneumatic fastening tools; namely, pneumatic screwdrivers, pneumatic torque motors, pneumatic angle head and pneumatic impulse drivers; aircraft and vehicle repair tools, namely frangible collar fasteners, rivet shavers, rivet millers, pneumatic saws, air scribe engravers, vacuum pens, impact wrenches, air ratchets, air sanders, air polishers, air grinders, air cutting tools, air drills, air hammers, air riveters, air screwdrivers and air rotary screw compressors, pneumatic deburrers, air scribe engraving pens; assembly tools, namely impact wrenches, pneumatic fastening screwdrivers and pneumatic torque motors, offset tube nut tools, closed end and crowfoot drivers, pneumatic angled drivers, pneumatic flush socket drivers, tool extenders for pneumatic drivers; hoists; planing machines, namely, planing machines for metal working and gear teeth; sawing machines, namely, shears, reciprocating saws, nibblers, high speed cutters boring machines; drilling machines, namely, in-line drills, angle drills, multi drills, rack feed drills, constant feed drills, peck feed drills, portable feed drill concentric colleters; machines for use in the working of metal, plastic, wood, fiberglass, ceramics and rubber, including, milling, grinding, drilling, sawing and planing machines; machines for automatically transferring, positioning and supporting work pieces for drilling machines, namely, pneumatic transporters, machine tool work piece holders positioners and, conveyors; power and pneumatically-operated hand held tools, namely, wrenches, torque controlled wrenches, blow guns, sanders and polishers, grinders, planing machines, shears, saws, reciprocating saws, nibblers, drills, angle drills, multi-drills, hammers, screwdrivers, tappers, air scribes/engraving pen, needle scaler, fastening tools, ratchets, compression tools, scalers, alligator jaws, yoke, pneumatically-driven saws, blow guns, tappers, hand-held drills, hand-held die grinders, orbital sanders, wrenches, namely, pneumatic wrenches, impact wrenches, power-driven wrenches, torque controlled wrenches, power and pneumatically-operated tools and machines, namely, torque controlled wrenches; blow guns, sanders and polishes, grinders, planing machines, shears, saws, reciprocating saws, nibblers, high speed cutters, drills, in-line drills, angle drills, multi-drills, rack feed drills, constant feed drills, peck feed drills, portable feed drill concentric colletting system, chisel scalers-riveting hammers, vibration reduced hammers, rivet shavers/millers, rotary screw compressors, tappers, pistol grip nut runners, in-line nut runners, angle head nut runners, fixture spindles, frangible collar fastener, vacuum cleaners, ESP controllers, compression tools, air motors, chippers, weld flex chippers, scalers, c yoke, grinders, routers, cutting tools, blow guns, tappers, belt sanders, electric dust extractors; edge formers in the nature of industrial rivet hammers, vibration reduced

rivet hammers, rivet shavers/millers; wheel grinders in the nature of turbine and power-operated grinders; machine tools used in the assembly and maintenance of vehicles, namely, pneumatic and electric/cordless wrenches, air ratchets, sanders and polishers, grinders, cutting tools, drills, hammers, riveters, screwdrivers and rotary screw compressors impacters and tappers, namely, pneumatic and electric driven tappers electronic electric motors and pneumatic motors for machines; pneumatic tools with multiple attachment heads for driving, fastening, cutting, and drilling, all being machine tools or parts of machine tools, namely, tool bits for machines, grinding tools for grinding machines, machine tools for use in the assembly of oil sumps and cylinder heads, including, wrenches and torque wrenches, twin-head attachments for use with drilling machines, namely, twin power drills, rack feeds, namely, rack conveyors; apparatus incorporating lubricators and filters and being parts of drilling rigs, including power operated lubricant dispensers for drilling machines, oil filters for mechanical purposes for use for drilling machines; chucks for power drills; clutches for machines; bushes, namely, parts in the nature of bushings for machines; valves, including, valves being part of pneumatic tools; bearings, namely, roller bearings for machines ball bearings for use in industrial applications and for use as machine parts power-operated grinding wheels; planing wheels, namely, abrasive wheels for power-operated planing machines mandrills; dies, namely, dies to use with machine tools; punches, namely, punching presses for metal working, pneumatic punches, corner rounding and slot punches, edge formers; sockets, namely, pneumatic operated socket wrenches and sockets; power-operated portable hand planing machines and power-operated abrading machines; structural parts for all the aforesaid goods--.

The identification of goods in International Class 17 has been accepted and should remain part of this application.

#### REMARKS

The Examining Attorney has required Applicant to submit a signed application, verified or supported by a Declaration under 37 CFR § 2.20. Applicant attaches as Exhibit 1 a signed application supported by a Rule 2.20 Declaration.

The Examining Attorney continued the refusal to register the mark because the listed goods were unacceptable as indefinite, and that some of the goods should be classified in other

International Classes. Applicant has amended the identification of goods to make the description more definite. Applicant has deleted goods which do not belong in the International Classes already included in the application.

In addition, Applicant requests that the identification of goods be amended to correct two typographical errors that were introduced when Applicant's previous amendments were entered by the USPTO into the Application, namely, a correction from "colieting system" to --colleting system--, and a correction from "all the aforesaid good" to --all the aforesaid goods--. These corrections have been included in the Amendment above.

Finally, the Examining Attorney has stated that colors in the drawing do not agree with the color claim and color location statement. Applicant attaches hereto as Exhibit 2 a substitute drawing showing the mark in the colors red, black, *grey* and white, as stated in the color claim and color location statement.

The Examining Attorney is advised that Applicant has filed a Notice of Appeal in the event that the Examining Attorney does not accept the amendment to the recitation of services. Applicant attaches hereto a copy of the Notice of Appeal as Exhibit 3.


All of the Examining Attorney's requirements having been satisfied, it is submitted that the present application is in condition for allowance. Further and favorable action passing the present mark to publication for opposition purposes is earnestly solicited.

Should the Examining Attorney have any further questions, he is invited to contact the undersigned at (703) 412-6442 or by e-mail at [tmdocket@oblon.com](mailto:tmdocket@oblon.com).

Respectfully submitted,

CHICAGO PNEUMATIC TOOL  
COMPANY

By:



Jordan S. Weinstein  
Oblon, Spivak, McClelland,  
Maier & Neustadt, P.C.  
1940 Duke Street  
Alexandria, Virginia 22314  
(703) 413-3000  
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e-mail: [tmdocket@oblon.com](mailto:tmdocket@oblon.com)

Date: October 23, 2007

JSW/KI/cli/ajc {I:\attyJSW\Chicago Pneumatic\3253-290883US-Res2.doc}

# **EXHIBIT 1**

BOX NEW APP FEE

Attorney Docket No.: 290883US56

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**  
**APPLICATION FOR TRADEMARK AND/OR SERVICE MARK REGISTRATION**

Mark: SPRINGHAMMER & Device

Class No.(s) 7

**TO THE HONORABLE COMMISSIONER OF PATENTS AND TRADEMARKS:**

Applicant is CHICAGO PNEUMATIC TOOL COMPANY, a corporation organized under the laws of New Jersey, located and doing business at 1800 Overview Drive, Rock Hill, South Carolina 29730-7463.

Applicant has adopted the mark shown in the accompanying drawing for the following goods/services:

Power tools; machine tools and tools for use with machine tools; hoists; planing machines, sawing machines, boring machines; drilling machines; machines for use in the working of metal, plastic, wood, fiberglass, ceramics and rubber; machines for automatically transferring, positioning and supporting workpieces for drilling and machining; power and pneumatically-operated hand held tools; wrenches; riveters, sheet <sup>metal</sup> punchers, edge formers, drills, die grinders, wheel grinders, sanders, hammers, all power and pneumatically-operated tools and machines; vacuum hoses for pneumatic tools; machine tools used in the assembly and maintenance of vehicles; impacters and tappers, electronic motors and pneumatic motors; multiple tools and tool heads, all being machine tools or parts of machine tools; machine tools for use in the assembly of oil sumps and cylinder heads; twin-head attachments for use with drilling machines; rack feeds; apparatus incorporating lubricators and filters and being parts of drilling rigs; chucks, clutches, bushes, valves, bearings and ball bearings, grinding wheels, planing wheels, mandrills, dies, punches, sockets, portable hand planing machines and abrading machines; parts and fittings for all the aforesaid goods, in International Class 7.

Please make of record the following color statement:

--The colors red, black, grey and white are claimed as features of the mark.--

Applicant requests registration of the mark in the United States Patent and Trademark Office on the Principal Register established by the Act of July 5, 1946 (15 U.S.C. § 1051, et seq., as amended).

Applicant has a bona fide intention to use the mark in commerce on or in connection with the above-identified goods or services (15 U.S.C. § 1051(b), as amended.)

The Applicant had a bona fide intention to use the mark in commerce on or in connection with the goods or services listed in the application as of the application filing date.

#### **POWER OF ATTORNEY**

The undersigned hereby appoints Jordan S. Weinstein, and the following attorneys of the law firm of OBLON, SPIVAK, McCLELLAND, MAIER & NEUSTADT, P.C., as its attorneys with full powers of substitution and revocation, to file and prosecute this application to register, to transact all business in the Patent and Trademark Office in connection therewith and to receive the Certificate of Registration:

Norman F. Oblon  
Marvin J. Spivak  
C. Irvin McClelland  
Gregory J. Maier  
Arthur I. Neustadt  
David J. Kera  
Jeffrey H. Kaufman  
Brian D. Anderson  
Roberta S. Bren  
Jonathan Hudis

Jordan S. Weinstein  
Brian B. Darville  
Kathleen Cooney-Porter\*  
Carol L.B. Matthews\*  
Colette Durst-Barkey  
Amy Sullivan Cahill  
Christopher I. Donahue  
Kyoko Imai  
Richard D. Kelly  
James D. Hamilton

Eckhard H. Kuesters  
Robert T. Pous  
Charles L. Gholz  
Jean-Paul Lavalleye  
Stephen G. Baxter  
Richard L. Treanor  
Steven P. Weihrouch  
Richard L. Chinn

Members of the Bar of Virginia (except as indicated)

\* Member of the Bar of the District of Columbia

Please address all correspondence to Jordan S. Weinstein at OBLON, SPIVAK, McCLELLAND, MAIER & NEUSTADT, P.C., 1940 Duke Street, Alexandria, Virginia 22314.



DECLARATION

The undersigned, being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any registration resulting therefrom, declares that he/she is properly authorized to execute this instrument on behalf of the applicant; he/she believes the applicant to be entitled to use such mark in commerce, and, to the best of his/her own knowledge and belief, no other person, firm, corporation, or association has the right to use said mark in commerce, either in the identical form or in such near resemblance thereto as to be likely, when applied to the goods or services of such other person, to cause confusion, or to cause mistake, or to deceive; the facts set forth in this application are true; and all statements made based on his/her own knowledge are true and all statements made on information and belief are believed to be true.

CHICAGO PNEUMATIC TOOL COMPANY

Signature: \_\_\_\_\_

Name: \_\_\_\_\_

Karl John BORGESON  
(printed or typewritten)

Title/Position: \_\_\_\_\_

Marketing Manager

Date: \_\_\_\_\_

06/06/06

JSW/dlb {I:\ATTY\JWS\3253-290883US-APP.DOC}



**DRAWING PAGE**

**APPLICANT'S NAME:**

**CHICAGO PNEUMATIC TOOL COMPANY**

**ADDRESS:**

1800 Overview Drive  
Rock Hill, South Carolina 29730-7463

**BASED ON:**

Intent to Use

**GOODS/SERVICES:**

Power tools; machine tools and tools for use with machine tools; hoists; planing machines, sawing machines, boring machines; drilling machines; machines for use in the working of metal, plastic, wood, fiberglass, ceramics and rubber; machines for automatically transferring, positioning and supporting workpieces for drilling and machining; power and pneumatically-operated hand held tools; wrenches; riveters, sheet metal punchers, edge formers, drills, die grinders, wheel grinders, sanders, hammers, all power and pneumatically-operated tools and machines; vacuum hoses for pneumatic tools; machine tools used in the assembly and maintenance of vehicles; impacters and tappers, electronic motors and pneumatic motors; multiple tools and tool heads, all being machine tools or parts of machine tools; machine tools for use in the assembly of oil sumps and cylinder heads; twin-head attachments for use with drilling machines; rack feeds; apparatus incorporating lubricators and filters and being parts of drilling rigs; chucks, clutches, bushes, valves, bearings and ball bearings, grinding wheels, planing wheels, mandrills, dies, punches, sockets, portable hand planing machines and abrading machines; parts and fittings for all the aforesaid goods, in International Class 7.



***SpringHammer***

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Jordan S. Weinstein  
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1940 Duke Street  
Alexandria, VA 22314  
(703) 413-3000

# **EXHIBIT 2**

**SUBSTITUTE DRAWING PAGE**

**APPLICANT'S NAME:**

CHICAGO PNEUMATIC TOOL COMPANY

**ADDRESS:**

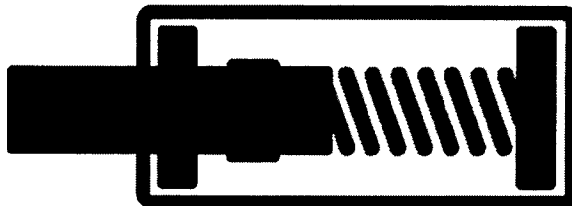
1800 Overview Drive  
Rock Hill, South Carolina 29730-7463

**BASED ON:**

Intent to Use

**GOODS/SERVICES:**

Power tools, namely, wrenches, torque controlled wrenches, electric brushless plugging and tightening wrenches, blow guns, sanders and polishers, grinders, planing machines, shears, saws, reciprocating saws, nibblers, high speed cutters, drills, in-line drills, angle drills, multi-drills, rack feed drills, constant feed drills, peck feed drills, portable feed drill concentric colleting system, industrial rivet hammers, vibration reduced hammers, rivet shavers/millers, screwdrivers, rotary screw compressors, battery-powered screwdrivers, high power and standard electric screwdrivers, low voltage screwdrivers and mains voltage screwdrivers, tappers, pistol grip nut runners, in-line nut runners, angle head nut runners, fixture spindles, frangible collar fastener, vacuum cleaners . . . etc., in International Class 017.



***SpringHammer***

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Jordan S. Weinstein, Esquire  
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1940 Duke Street  
Alexandria, VA 22314  
(703) 413-3000

# **EXHIBIT 3**

Attorney Docket No.: 290883US56

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**  
**BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In re the Application of:

CHICAGO PNEUMATIC TOOL  
COMPANY

Application Serial No.: 76/659,543

Filed: May 3, 2006

Mark: SPRINGHAMMER & DEVICE

Class: 7

The Trademark Trial and Appeal Board  
P.O. Box 1451  
Alexandria, VA 22313-1451

Dear Commissioner:

Examining Attorney

Steven Jackson

Law Office 107

**TTAB  
FEE**

**NOTICE OF APPEAL**

Applicant, CHICAGO PNEUMATIC TOOL COMPANY, hereby appeals from the final refusal issued by the Examining Attorney, pursuant to Rules 2.141 and 2.142(a) of the Trademark Rules of Practice.

We enclose our credit card payment form or check for the required filing fee for this Notice of Appeal. The Commissioner is hereby authorized to charge any additional fees which may be required, or credit any overpayment, to Account No. 50-2014.

Respectfully submitted,

CHICAGO PNEUMATIC TOOL  
COMPANY

By:

  
Jordan S. Weinstein

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Date: October 23, 2007

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